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10/820,411

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Dale W. Malik

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT

PAPER NUMBER

2163

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,411

Applicant(s)

MALIK, DALE W.

Examiner

Marc R. Filipczyk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

This action is responsive to Applicant's response filed on November 9, 2007.

Claims 21-40 are pending.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claim 28 does not involve transformation of article or physical object to a different state or thing, they merely recite searching data. Further, independent claims 21, 28 and 35 do not produce a useful, concrete, and tangible result, but merely search data to obtain a result so that a score can be determined, however, no electronic

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data or computer generated data is created and stored for usefulness and reusability. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claim 28 taken as a whole is directed to a mere method, i.e., to only its description or expression, an abstract idea, do not comprise a practical application as explained above hence is nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 29-34 which depend from claim 28 respectively, are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As to claims 23-25, 30-32 and 37-39, the limitation of “determine, from the combined score, a risk...” was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There are no teachings of or criteria that account for a complete and useful implementation of a combined score to determine risk.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25, 30-32 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 23-25, 30-32 and 37-39, the terms "risk" and "magnitude of risk" are indefinite. The metes and bounds of risk are not clear. There are no teachings of such as an algorithm or function or criteria that account for or teach a complete and useful implementation of a combined score to determine any risk. Since risk is not clearly claimed measuring a magnitude of risk is even more unclear.

Claim 21-40 recites the limitation "the number of occurrences" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 21-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Woods (U.S. Patent No. 6,101,491) in view of Clark et al. (herein Clark) (U.S. Publication No. 2004/0153663).

Regarding claims 21, 28 and 35, Woods teaches a system, medium method and program comprising (fig. 1 and abstract):

means for searching for a first piece of sensitive information (fig. 1, items 120, 130 and *query & parameters*);

means for searching for a second piece of sensitive information (figs. 1 and 4, items 130 and 410);

means for obtaining a result for the first piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for obtaining a result for the second piece of sensitive information (fig. 1, items 120, 130, 140 a,b and *hits*);

means for assigning a first score, the first score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data (figs. 1 and 5, item 530, also see figs. 1 and 4, items 120, 130, 140a,b, 410-440 and *scores*);

means for assigning a second score, the second score being determined from the number of occurrences of the first piece of sensitive data, as revealed in the search for the first piece of sensitive data (figs. 1 and 5, item 530); and,

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means for assigning a third score to the sensitive information, the third score being a function of the first score and the second score (fig. 5, items 540, 550 and 560, and col. 9, lines 19-35, *merge hits & scores and results*).

means for providing the third score to a user (fig. 5, items 540, 560 also see figs. 1 and 6), but Woods fails to explicitly teach that the sensitive information includes personal information regarding at least one user and to determine a risk for at least one identity related vulnerability.

However, Clark teaches searching, analyzing and comparing data including personal information regarding a user (figs 1 and 2, elements 10 and 12) to determine a relative fraud risk (abstract and figures 1 and 2 items 12, 60, 70, 82, 90, 100 and related text, Clark). Therefore, it would have been the ordinary skilled artisan's assessment that it would have been obvious to use Clark's personal user information and analyzing method in Woods system to identify related vulnerability (abstract and figures 1 and 2, and related text, Clark) by specifically searching for personal information as taught by Clark. One of ordinary skill in the art would have been motivated to combine Woods with Clark because both systems search, analyze and compare data.

Regarding claims 22, 29 and 36, Woods and Clark discloses sensitive information includes one of: a name, an address, a social security number and telephone number and an email address (see fig. 2, item 250 and related text, Woods).

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Regarding claims 23-25, 30-32 and 37-39, Woods and Clark disclose the combined score can be used for a number of analysis, including a magnitude of risk (fig. 2, all the elements and item 90, and related text, Clark).

(Note: related query hits and scores are used based on user/client application and include many uses in security applications)

Regarding claims 26, 27, 33, 34 and 40, Woods and Clark disclose the piece of sensitive information is configured to search web pages (col. 6, lines 46-48, Woods).

Response to Arguments

Applicant's amendment and remarks submitted on November 9, 2007 have been fully considered but they are not persuasive. The arguments and responses are listed below:

Applicant argues that "providing the combined score to a user" is statutory.

Examiner disagrees. A useful, concrete, and tangible electronic result that could be reused is not generated. Instead, the claimed score provided to a user could be written to a user on a piece of paper with a pencil which is not tangible. Please refer to the rejections above for more information.

Applicant argues that risk is definite and enabling.

Examiner disagrees. Applicant's disclosure does not teach criteria that account for a complete and useful implementation of a combined score to determine risk. In other words, it is

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not clear what constitutes a risk, or more precisely, it is not clear what constitutes a degree or magnitude of risk. Even though Applicant points to the specification on page 14 that if there is no occurrences of social security, the risk of identity theft is relatively low, the metes and bounds of risk are not disclosed because risk is difficult to measure and identify. There are no teachings of an algorithm or function or criteria that account for or teach a complete and useful implementation of a combined score to determine any risk. As such, the rejection stands.

Applicant contends that the amended independent claims are allowable over Woods because Woods does not teach "determining... a risk" or "personal information" or "a number of occurrences" and that Clark does not teach "personal information" or "a number of occurrences".

Examiner disagrees. With regard to Woods, Woods teaches a number of occurrences and displays them as hits. It is well known to an ordinary artisan skilled in the searching arts that searching and matching data generates hits. The claims further do not require keeping count of the number of hits or counts. As to "personal information", it is well known to an ordinary artisan skilled in the searching arts that searches may be provided against any data available in the database or the world wide web, including personal user profiles. Although Woods does not expressly teach searching personal information but instead teaches searching any type of information Clark implicitly teaches collecting client data including address information (figs. 1 and 2, elements 10, 12, 20 and 100) and analyzes the personal information to detect fraud (par. 28, Clark). Since Applicant does not dispute Clark's teaching with regard to fraud detection or any other issues, the rejection of Woods in view of Clark stands.

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With respect to all the pending claims 21-40, Examiner respectfully traverses Applicant's assertion based on the discussion and rejection cited above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

January 9, 2008



WILSON LEE
PRIMARY EXAMINER